

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1-2, 14-15, 21-22, 34-35, and 41 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102

On page 2 of the Office Action, the Examiner rejects claims 1-9, 12-15, 21-29, 32-35, and 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereafter Steinberg). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Steinberg fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 21 which are now amended to recite “*said data source being implemented as a computer in a distributed computer network,*” and “*said ancillary data module performing one or more on-line management procedures for said ancillary data files while an active communication path exists to said computer in said distributed computer network,*” which are limitations that are not

taught or suggested either by the cited references, or by the Examiner's citations thereto.

Steinberg is limited to teaching "a camera having a built in microprocessor for accepting configuration data" (see column 2, lines 18-19). In contrast, Applicants nowhere disclose or claim accessing configuration data. Applicants therefore submit that Steinberg is not analogous to the claimed invention.

Applicants further submit that Steinberg nowhere discloses "on-line management procedures" with respect to "ancillary data files", as claimed by Applicants. For at least the foregoing reasons, Applicants therefore submit that the claimed invention is not anticipated by the teachings of Steinberg.

With regard to claim 42, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Steinberg and Applicants' invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Steinberg.

Regarding the Examiner's rejection of dependent claims 2-9, 12-15, 22-29, and 32-35, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-9, 12-15, 22-29, and 32-35 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Steinberg to identically teach the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-9, 12-15, 21-29, 32-35, and 42, so that these claims may issue in a timely manner.

On page 6 of the Office Action, the Examiner rejects claims 1-17, 21-37, and 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,477,264 to Sarbadhikari et al. (hereafter Sarbadhikari). The Applicants respectfully traverse these rejections for at least the following reasons.

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Sarbadhikari fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §102 rejection as if applied to amended independent claims 1 and 21 which are now amended to recite "*said data source being implemented as a computer in a distributed computer network,*" and "*said ancillary data module performing one or more on-line management procedures regarding said ancillary data files while an active communication path exists from said imaging device to said computer in said distributed computer network,*" which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto.

Sarbadhikari is limited to teaching "an electronic camera for capturing and storing images in a removable storage device which is also preloaded with software for operating the imaging system (see column 2, lines 54-56). In contrast, Applicants affirmatively claim a data source that is "implemented as a computer in a distributed computer network." Applicants further submit that Sarbadhikari nowhere discloses "performing one or more on-line management procedures regarding said ancillary data files while an active communication path exists from said imaging device to said computer," as claimed by Applicants. For at least the foregoing reasons, Applicants therefore submit that the claimed invention is not anticipated by the teachings of Sarbadhikari.

With regard to claim 42, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have

frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Sarbadhikari and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Sarbadhikari.

Regarding the Examiner’s rejection of dependent claims 2-17 and 22-37, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-17 and 22-37, so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Sarbadhikari to identically teach the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-17, 21-37, and 42, so that these claims may issue in a timely manner.

35 U.S.C. § 103

On page 11 of the Office Action, the Examiner rejects claims 18-20 and 38-40 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of U.S. Patent No. 6,177,957 to Anderson (hereafter Anderson). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Sarbadhikari according to the teachings of Anderson would produce the claimed invention. Applicants submit that Sarbadhikari in combination with Anderson fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Sarbadhikari nor Anderson contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore

respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 18-20 and 38-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 18-20 and 38-40, so that these claims may issue in a timely manner.

Furthermore, with regard to claims 18 and 38, the Examiner concedes that Sarbadhikari fails to teach an "off-line management procedure including a file descriptor identification procedure" Applicants concur. The Examiner then points to Anderson to purportedly remedy these deficiencies. Anderson is limited to teaching a camera device that accesses "executable files" from a "flash disk". Applicants therefore submit that neither Anderson nor Sarbadhikari teach a "data source being implemented as a computer in a distributed computer network," as claimed by Applicants. Applicants further submit that neither Anderson nor Sarbadhikari teach "performing one or more on-line management procedures for said ancillary data files while an active communication path exists to said computer in said distributed computer network," as claimed by Applicants.

With regard to claims 19 and 39, the Examiner concedes that Sarbadhikari fails to teach certain limitations claimed by Applicants. Also with regard to

claims 20 and 40, the Examiner again concedes that Sarbadhikari fails to teach certain limitations claimed by Applicants. However, the Examiner makes no further comments or remarks regarding why these four claims are rejected. Applicants respectfully request the Examiner to provide specific citations supporting the rejection of claims 19-20 and 39-40, or in the alternative to allow these four dependent claims so that they may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 18-20 and 38-40 are not unpatentable under 35 U.S.C. § 103 over Sarbadhikari in view of Anderson, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 18-20 and 38-40 under 35 U.S.C. § 103.

On page 13 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Steinberg. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

In the rejections of claim 41, the Examiner states that certain claimed limitations are "well known and expected in the art" as support for the rejection

without providing any specific references for support. Because Applicants maintain that the limitations of claim 41 were not well-known in the particular art at the time of the invention, Applicants therefore respectfully request the Examiner to cite specific references in support of this rejection, and failing to do so, to reconsider and withdraw the rejection of claim 41, so that this claim may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that the cited reference, in combination with the Official Notice, do not suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found.

For at least the foregoing reasons, the Applicants submit that claim 41 is not unpatentable under 35 U.S.C. § 103 over Steinberg, and that the rejection under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 41 under 35 U.S.C. § 103.

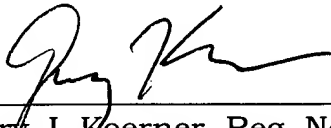
Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 10/20/04

By: _____


Gregory J. Koerner, Reg. No. 38,519
SIMON & KOERNER LLP
10052 Pasadena Avenue, Suite B
Cupertino, CA 95014
(408) 873-3943